

Building - Suite 900 | 200 Delaware Avenue | Buffalo, NY 14202-2107 | bsk.com

JEREMY P. OCZEK
jpoczek@bsk.com
P: 716.416.7037

June 30, 2022

Honorable Katharine H. Parker
United States District Court for the Southern District of New York
Daniel Patrick Moynihan United States Courthouse
500 Pearl Street
New York, NY 10007-1312

Re: Joint Status Letter – Civil No. 1:21-cv-09472-JGK-KHP

Dear Magistrate Judge Parker:

Pursuant to the Court's Order dated June 1, 2022 (Docket No. 42), the parties provide the following joint status letter.

Plaintiff's Statement:

1. *Nature of Claims.* This is an action asserting claims for breach of contract, specific performance, and unjust enrichment. The Court has diversity jurisdiction pursuant to 28 U.S.C. § 1332(a)(1). There is complete diversity between the parties, as Plaintiff Signify Holding B.V. ("Signify") is a citizen of The Netherlands and Defendants TP-Link Research America Corporation and TP-Link USA Corporation are citizens of the state of California.

2. *Case Background.* Signify, formerly known as Philips Lighting, is a global market leader for lighting products with recognized expertise in the development, manufacturing, and application of innovative LED lighting solutions. To protect its intellectual property resulting from its significant investments, Signify applied for and obtained numerous patents directed to various LED inventions and technologies. For example, Signify has thousands of patents and hundreds of pending patent applications covering technologies related to LED luminaires and retrofit bulbs. Signify has developed a license program under which companies using Signify's patents may be able to obtain a license. Currently, more than 1300 companies worldwide have taken licenses under this program.

On or about December 1, 2018, Signify (then known as Philips Lighting Holding B.V.) and TP-Link Research America Corporation and its Affiliates entered into a Patent License Agreement (written in English) and granted TP-Link Research America Corporation and its Affiliates a patent license under the terms and conditions of the License Agreement. However, TP-Link has failed to live up to its obligations under the License Agreement, for example, by failing to provide reports and written statements required by the License Agreement and by failing to pay the required royalties to Signify. TP-Link has refused to acknowledge, cease, or remedy its breaches of the License Agreement, and Signify has

Honorable Katharine H. Parker
June 30, 2022
Page 2

been damaged, and continues to be damaged, by such breaches. Signify seeks money damages against Defendants for breach of contract, declaratory relief in the form of an order of specific performance of contractual terms between the parties, and restitution for unjust enrichment.

3. *Status of Discovery.* Signify has sought discovery from Defendants on the following topics: 1) Plaintiffs' claims as set forth in the Complaint; 2) the corporate structure and relationship of Defendants and Defendants' Affiliates; 3) Sales information for all sales under the parties' license agreement (December 1, 2018 through present), including information about final sale price, units sold, selling entity, purchasing entity, date of transaction, and SKU/Product Number, and including sales made by Defendants' domestic and foreign Affiliates; 4) the audit conducted by Plaintiff of TP-Link Research America Corporation; and 5) the amount of royalties, if any, owed by Defendants.

On February 2, 2022, Signify served interrogatories and requests for the production of documents to Defendants. The parties met and conferred in March, April and May on various discovery issues raised by Signify, and Defendants subsequently amended certain of their discovery responses on June 23, 2022.

On June 8, 2022, Signify served Rule 30(b)(6) deposition notices to the Defendants. These depositions are scheduled to proceed on July 25 and 26, 2022 in Irvine, California. Defendants have not identified the designated witnesses for these depositions other than to say that "The deposition of the TP-Link Research America Corporation representative will be in Mandarin Chinese (the other in English)." Signify has attempted to discuss this matter with Defendants. Signify respectfully objects to the designation of a non-English corporate designee for TP-Link Research America Corporation as the company is a US-based company whose corporate communications have been in English. Additionally, the Patent License Agreement between the parties is in English. Signify respectfully seeks the Court's guidance on this issue.

On June 28, 2022, Signify filed a Letter Motion pursuant to Local Civil Rule 37.2 requesting a pre-motion conference regarding a discovery dispute. The dispute concerns financial documents provided to Signify during settlement discussions which Defendants now refuse to produce in the case despite counsel for Defendants' representation to the Court at the May 31, 2022 discovery conference.

Per the Scheduling Order (Docket No. 21) fact discovery is to be completed in this case by August 31, 2022.

Honorable Katharine H. Parker
June 30, 2022
Page 3

Defendants' Statement:

The first half of Plaintiff's statement above repeats complaint allegations that have little relevance to case status; suffice it to say, Defendants dispute such allegations. See Docket 19 (Defendants' Amended Answer).

Discovery is proceeding apace. Discovery responses have been recently updated; documents have been (and are still being) produced; and depositions have been scheduled. Signify's Letter Motion on June 28, 2022, was premature and filed in violation of Local Civil Rule 37.3—Defendants will provide a full response to that letter after the holiday weekend. Otherwise, there are no issues ripe for the Court's attention.

* * * * *

Respectfully submitted,

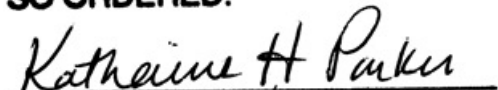
s/ Jeremy P. Oczek
Jeremy P. Oczek
Counsel for Plaintiff Signify Holding B.V.

cc: Counsel of Record (via ECF)

The Court thanks the parties for this status update. A telephonic Case Management Conference is scheduled on **Thursday, July 14, 2022, at 11:00 a.m.** Parties will have the opportunity to discuss the discovery issues that Plaintiff raised in ECF Nos. 47 and 48 at this Conference, as well as any other discovery issues that may arise. Counsel for the parties are directed to call Judge Parker's AT&T conference line at the scheduled time. Please dial (866) 434-5269; access code 4858267.

The Clerk of the Court is requested to terminate the motion at ECF No. 47.

SO ORDERED:



HON. KATHARINE H. PARKER
UNITED STATES MAGISTRATE JUDGE 7/5/2022